

Remarks

Claims 1-9, 11-12, 16 and 19-26 are pending in this application and have been rejected. Claims 1-8 have previously been withdrawn from consideration. By this response, no claims have been amended and the Applicants have tendered argument in response to the various rejections raised by the Examiner. Favorable reconsideration of the claims is respectfully requested. No new matter has been added.

Rejection Of Claims 22, 23, 25 And 26 Under 35 U.S.C. § 112

Claims 22, 23, 25, and 26 were rejected under § 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

The Examiner asserted that claims 22, 23, 25 and 26 contains “subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” *See* November 14, 2006 Office Action, paragraph 2. The Examiner further asserted that the “specification does not provide support for a surface of the first tool defining said mold cavity comprises a recess to receive a third material.” *Id.* This is incorrect.

Claims 22 recites “a surface of said first tool defining said first cavity comprises a recess to receive a third material.” Similarly, claim 25 recites “a surface of said first tool defining said mold cavity comprises a recess to receive a third material.” Both of these claims are amply supported by the original application. For instance, Figure 8 discloses an insert 46 made of a third material received within a recess in a surface of the first tool defining the mold cavity. Furthermore, paragraph 32 of the original application reads, in pertinent part, as follows:

With reference to Figure 8, a third material may be inserted within first cavity 30 of mold 20. The third material may be any suitable material, such as a first insert 46 or a second insert 48. Inserts 46 and 48 may be any suitable insert formed of a desired material, such as polypropylene or steel. Preferably, first insert 46 is relatively rigid having a decorative or ornamental surface. First insert 46 is preferably positioned within or adjacent to mold surface 28.

As demonstrated above, the specification, including Figure 8, provides ample support for the limitation requiring that "a surface of the first tool defining said first cavity comprises a recess to receive a third material." Accordingly, Applicants believe that the Examiner's rejection of claims 22 and 25 under 35 U.S.C. § 112 has been overcome and Applicants respectfully request that the Examiner withdraw this rejection of claims 22 and 25 and allow them to issue.

The Examiner has also rejected claims 23 and 26 under 35 U.S.C. § 112 on the grounds that they are not supported by the specification. This is incorrect. Claims 23 and 26 both include a limitation where "a surface of the mold element has a protrusion to form a recess within the receptacle." This limitation is amply supported by the Applicants' original application. Figure 9 clearly demonstrates that the mold element 34A includes a protrusion having a mold surface 50. As illustrated in Figure 10, a component molded by the mold of Figure 9 results in a component having a recess, (for instance, a channel 52 as in the case of the component illustrated in Figure 10). Further support for claims 23 and 26 can be found in paragraphs 35, 36 and 37 of the original application which read as follows:

Unlike mold assembly 20, mold assembly 20A includes a core 34A having a fourth mold surface 50. As illustrated in Figure 9, when core 34A is placed in first position, third mold surface 36A defines a portion of second mold surface 28A, and fourth mold surface 50 obstructs a portion of second cavity 38A, shown in phantom line in Figure 9. In the second position (not shown), core 34A is moved downward within core cavity 38A, such that both third mold surface 36A and forth [*sic*, fourth] mold surface 50 obstruct cavity 38A.

As illustrated in Figure 10, when core 34A is positioned in first position, first material 40A, injected through first passage 42A, hardens to form a channel 52 within panel 12, the formation of channel 52 being caused by the penetration of fourth mold surface 50 within the second cavity 38A. The presence of the channel 52 within panel 12 has a variety of uses but is particularly desirable for attaching a decorative piece, such as a wood grained or metallic trim piece. After first material 40 hardens, panel 12 is removed from mold assembly 20A by any suitable method.

To produce panel 12 having both channel 52 and recess 14, core 34A is moved to the second position before material 40 is injected through first passage 42A. Specifically, the obstruction of second cavity 38A by third surface 36A and fourth surface 50 results in the formation of recess 14 and channel 52 when first material 40A hardens. Bolster 16 may then be secured within cavity 38A in any suitable manner, such as by heat staking tabs 47 to cavity 38A and channel 52 using a suitable heat staking device (Figure 11A).

As demonstrated above, the specification, including Figures 9 and 10, provides ample support for the limitation "a surface of the mold element has a protrusion to form a recess within the receptacle." Applicants respectfully contend that the Examiner's rejection of claims 23 and 26 under 35 U.S.C. § 112 has been overcome. Accordingly, Applicants request that the Examiner withdraw this rejection and allow claims 23 and 26 to issue.

**Rejection Of Claims 9, 11, 16, 20, 21 and 24 Under 35 U.S.C. § 103
As Being Obvious Over Iida In View Of Hatakeyama**

Claims 9, 11, 16, 20, 21, and 24 were rejected under § 103(a) as being unpatentable over U.S. Patent Application No. 2001/0005541, issued to Iida (hereinafter "Iida") taken together with French Patent No. 2,572,676 issued to Hatakeyama et al. (hereinafter "Hatakeyama"). Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three criteria must be met. "First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.” MPEP § 2143. Importantly, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants’ disclosure.” *Id.*; *see also In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

In this case, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) because the combination of Iida with Hatakeyama does not teach or suggest all of the limitations of the rejected claims. Furthermore, there is no suggestion or motivation to combine these references.

The Combination Of Iida With Hatakeyama Does Not Teach Or Suggest All Of The Claim Limitations

Independent claim 9 reads as follows, with the language that is most relevant to the Examiner’s rejection shown in bold:

An automotive vehicle tooling system for manufacturing a trim panel assembly comprising:

a **first tool** operable to produce a first component of a first material, said first tool having a first cavity and a second cavity, said first tool further having a mold element movable between a first position to expose said second cavity and a second position to block said second cavity, said first tool receiving said first material and producing said panel having a receptacle when said mold element is positioned in said second position; and a **second tool different than said first tool** operable to produce a second component having a second material different than said first material;

wherein said second component is secured within said receptacle of said first component.

Independent claim 16 reads as follows, with the language that is most relevant to the Examiner's rejection shown in bold:

An automotive trim panel assembly and a tooling system for producing the automotive trim panel comprising:

a first tool having a mold cavity and a mold element movable between a first position in which at least a majority of the mold element is positioned outside the cavity and a second position in which the element at least substantially obstructs the cavity;

a second tool assembly different from the first tool assembly;

manufacturing a first component of the trim panel assembly by inserting a first material within the first tool with the mold element in the second position to form a receptacle within said first component;

manufacturing a second component of the trim panel assembly using the second tool assembly and a second material;
and

securing the second component within the receptacle of the first component.

As set forth above, independent claims 9 and 16 both require "a first tool" and "a second tool" that is **different than the first tool**. As set forth in Applicants' August 25, 2006 response to the Examiner's April 6, 2006 Office Action, Hatakeyama '676 does not disclose "a second tool different than said first tool." The Examiner did not dispute this assessment in the November 14, 2006 Office Action. Accordingly, for the combination of Hatakeyama and Iida to teach or suggest each and every element of Applicants' independent claims 9 and 16, Iida would have to disclose a second tool that is different than the first tool. It does not. Rather, Iida discloses an apparatus and method for attaching emblems to molded articles. Specifically, Iida discloses "[a] structure and method for fastening an emblem to a molded article by inserting thermoplastic resin mounting feet, protruding from the emblem, through holes formed in the molded article and subsequent thermal deformation of the feet to establish a secure attachment." *See* Iida, Abstract. Iida does not expressly disclose any tools, let alone a second tool that is different than a first tool. Accordingly, the combination of Iida

with Hatakeyama fails to supply this claim limitation of Applicants' independent claims 9 and 16.

The Examiner admitted that Iida does not expressly disclose "a first tool" and "a second tool" that is different than the first tool when the Examiner stated that "[t]he tools for forming the first and second molded articles are **inherent**" (as opposed to literally or expressly present.) See the Examiner's November 14, 2006 Office Action, page 3, paragraph 5 (emphasis added). To establish inherency, the missing descriptive matter must **necessarily** be present in the thing described in the reference. "The law requires that inherency may not be established by **possibilities or probabilities**. The evidence **must show** that the inherency is **necessary and inevitable**." *Interchemical Corp. v. Watson*, 145 F.Supp. 179, 182 (Dist. D.C. 1956), *aff'd* 271 F.2d 390 (D.C. Cir. 1958) (emphasis added). The mere fact that a certain thing **may** result from a given set of circumstances is **not sufficient**. *In re: Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (emphasis added). On the issue of inherency, the C.C.P.A. has held as follows: "[i]n the case of *In re Dragee et al*, 150 F.2d 572, 574, 32 C.C.P.A. (Patents) 1217, this Court said "citing numerous cases in point): 'inherency does not mean that a thing might be done or that it might happen, as in the instant case, one out of twenty odd times; but it must be disclosed, if inherency is claimed, that the thing will **necessarily** happen.'" *Giambalvo v. Detrick*, 168 F.2d 116, 120 C.C.P.A. 1948 (emphasis added).

As applied here, for the Examiner to rely on the principle of inherency, it is not sufficient that the two components of Iida **might** have been molded in separate tools. Rather, they **must necessarily** have been molded in separate tools. Given the presence in the molding industry of tools having multiple cavities, the two components of Iida were not **necessarily** molded in separate tools. Thus, the Examiner cannot rely on inherency to establish that Iida discloses "a first tool" and "a second tool" that is different than the first tool.

**There Is No Motivation, Teaching Or Suggestion To Combine
The Teachings Of Hatakeyama With The Teachings Of Iida**

To rely on the combination of Hatakeyama with Iida, the Examiner must show the presence of some teaching, suggestion or motivation to combine these references and such teaching, suggestion or motivation must come from the references, not Applicants' disclosure. Here, such teaching, suggestion or motivation is lacking.

Hatakeyama discloses a molding apparatus comprising opposing mold members (12, 14) defining a cavity (40). The second mold member (14) has a movable core (20) that is positionable to form a recess in a first injected material and then withdrawn to leave a recess in a molded component to allow the injection of a differently colored material into the recess of the molded component. Use of the apparatus disclosed by Hatakeyama will result in a unitary component comprised of two differently colored materials as best illustrated in Figure 3 of Hatakeyama. Hatakeyama does not teach or otherwise disclose an apparatus or a method which results in the formation of a component having a recess or cavity into which a separately molded second component is to be inserted and attached.

Iida, by contrast, concerns itself with solving the problem of how to connect to separate components.

A person of ordinary skill in the art seeking to solve the problems of how to mold a structure having two differently colored materials would have no reason to look to the art of connecting together two separate components. Further, a person of ordinary skill in the art seeking to solve the problem solved by Iida would not look to the art of molding a single structure having two colors. Accordingly, there is no teaching, suggestion or motivation to combine Iida with Hatakeyama.

For all of the foregoing reasons, the Applicants believe that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) and that this

rejection of independent claims 9 and 16 has been overcome. Applicants respectfully request that the Examiner withdraw this rejection and allow independent claims 9 and 16 to issue.

Claims 11 and 21 depend from independent claim 9 and claims 20 and 24 depend from independent claim 16. Accordingly, for at least the same reasons that independent claims 9 and 16 are not obvious under 35 U.S.C. § 103(a) over the combination of Iida and Hatakeyama, dependent claims 11, 20, 21 and 24 are also not obvious. Additionally, dependent claims 21 and 24 require that “a surface of the mold element has a protrusion to form a recess within the receptacle.” The mold element of Hatakeyama does not contain a “protrusion” as required by dependent claim 21. For this additional reason, the combination of Hatakeyama with Iida fails to disclose each and every element of dependent claims 21 and 24. Accordingly, Applicants submit that the Examiner’s rejection of dependent claims 11-20, 21 and 24 have been overcome and respectfully request that the Examiner withdraw this rejection and allows these claims to issue.

**Rejection Of Claims 9, 12, 16 And 19 Under 35 U.S.C. § 103
As Being Obvious Over Iida In View Of Watanabe**

Claims 9, 12, 16 and 19 were rejected under § 103(a) as being unpatentable over Iida ‘541 et al. taken together with Japanese Patent No. JP 62-108019 issued to Watanabe. Applicants respectfully traverse this rejection.

**The Combination Of Iida With Watanabe Does Not Teach Or
Suggest All Of The Claim Limitations**

As set forth in the section above, independent claims 9 and 16 both require “a first tool” and “a second tool” that is **different from the first tool**. As set forth in Applicants’ August 25, 2006 response to the Examiner’s April 6, 2006 Office Action, Watanabe does not disclose “a second tool” that is different than “a first tool.” The Examiner did not dispute this assessment in the November 14, 2006 Office Action. Accordingly, for the combination of Watanabe and Iida to teach or suggest each and every element of Applicants’ independent claims 9 and 16, Iida would have to disclose a second tool that is different than the first tool.

As set forth in detail above, it neither expressly nor inherently discloses a first tool and a second tool that is different than the first tool. Accordingly, the combination of Iida with Watanabe fails to supply this claim limitation of Applicants' independent claims 9 and 16.

**There Is No Motivation, Teaching Or Suggestion To Combine
The Teachings Of Watanabe With The Teachings of Iida**

Watanabe discloses a method and apparatus for molding multi-color synthetic resin molding and product thereof. According to its Abstract, the purpose of Watanabe "[t]o obtain synthetic resin moldings having integrally combined different color portions and other portions without delamination at low cost on a mass production basis" The use of the apparatus and method of Watanabe will result in a unitary component comprised of two differently colored materials. Watanabe does not teach or otherwise disclose an apparatus or method which results in the formation of a component having a recess or cavity into which a separately molded second component is to be inserted or attached.

As set forth above, Iida is concerned with solving the problem of how to connect two separate components.

A person of ordinary skill in the art seeking to solve the problems of how to mold a structure having two differently colored materials would have no reason to look to the art of connecting together two separate components. Additionally, a person of ordinary skill in the art seeking to solve the problem of how to connect two separate components would not look to the art of molding a single structure having two colors. Accordingly, there is no teaching, suggestion or motivation to combine Iida with Watanabe.

For all of the foregoing reasons, the Applicants believe that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) and that this rejection of independent claims 9 and 16 has been overcome. Applicants respectfully request that the Examiner withdraw this rejection and allow independent claims 9 and 16 to issue.

Claim 12 depends from claim 9. Claim 19 depends from claim 16. Accordingly, for at least the same reasons that independent claims 9 and 16 are not obvious under 35 U.S.C. § 103(a) over the combination of Iida and Watanabe, dependent claims 12 and 19 are also not obvious. Accordingly, Applicants submit that the Examiner's rejection of dependent claims 12 and 19 have been overcome and respectfully request that the Examiner withdraw this rejection and allow these claims to issue.

Conclusion

Applicants have made a genuine effort to respond to the Examiner's objections and rejections in advancing the prosecution of this case. Applicants believe all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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